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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05-CV-1114 JW **SATELLITE DEFENDANTS' MEMORANDUM RE THE DEFINITIONS OF TERMS IN THE '863 AND '720 PATENTS** Date: Sept. 7-8, 2006 Time: 9:00 a.m. Courtroom: 8, 4th Floor Judge: Hon. James Ware

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INTRODUCTION

Construing the ‘863 and ‘720 patents is particularly challenging because the claims of both patents contain numerous terms that do not appear anywhere in the specification and are not terms with specialized meanings in the relevant art. Many of those terms — including “central processing location,” “representation,” and “subscriber receiving station” — defy attempts to arrive at an unambiguous construction and should be found indefinite. For other claim terms, the specification and prosecution history suggest an appropriate claim construction, which should be adopted. Acacia’s proposed constructions frequently ignore the claim language, failing to give meaning to the claims as written. For example, Acacia’s proposed definition of “local distribution system” simply ignores the word “local” completely. Other Acacia proposals use language that is so vague as to be even less understandable than the claims themselves. For all of these reasons, the Court should adopt the Satellite Defendants’ proposed constructions of the disputed terms of the ‘863 and ‘720 patents.

ARGUMENT

The current round of *Markman* briefing is limited to the terms of the ‘863 and ‘720 patents. Acacia accuses EchoStar and DIRECTV (the “Satellite Defendants”) of infringing Claims 17-19 of the ‘863 patent and Claims 4, 6-8, and 11 of the ‘720 patent. The Satellite Defendants therefore jointly address the disputed terms from these claims.

I. THE TERM “CENTRAL PROCESSING LOCATION” IS INDEFINITE[1]

A patent specification must “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. The claims, read in light of the specification, must “reasonably apprise those skilled in the art both of the utilization and scope of the invention.” *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985). A patent that fails to meet this requirement is invalid for indefiniteness.

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[1] The parties’ positions on construction of this term are found in Item Nos. 1 and 12 in the Joint Claim Chart.

The definiteness of claim language is assessed from the standpoint of one skilled in the art. *Id*; *see also Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377-78 (Fed. Cir. 2000) ("[O]ur precedent is well-settled that a court will typically limit its inquiry [in analyzing an issued patent's compliance with 35 U.S.C. § 112, ¶ 2] to the way one of skill in the art would interpret the claims in view of the written description portion of the specification."). While courts will try to construe even difficult claims, if a patent claim and specification provide no proper narrowing construction, the claim will be deemed "insolubly ambiguous" and invalid for indefiniteness. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001); *see also Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004).

As Acacia admits, the term "central processing location," which appears in Claims 14 and 17 of the '863 patent and Claims 8 and 11 of the '720 patent, is not used in the specification. Although patentees are given latitude in defining their invention differently from the terms used in the specification, that latitude is not without bounds. *See Manual of Patent Examining Procedure*, § 2173.05(e) (8th ed., rev. 3, Aug. 2005) (different terms must still define the invention "with a reasonable degree of clarity and precision"). Patentees are required to "make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained." *Id*. § 2173.05(a). Because the term "central processing location" does not have a common and ordinary meaning, is not a term known to persons of skill in the art, and is not used, let alone defined, in the specification, its "metes and bounds" cannot be ascertained. Therefore, the term is not amenable to construction, and the Court should hold that it is indefinite.

A. The Word "Central" is Not Sufficiently Precise to Define the Bounds of the "Central Processing Location."

Acacia concedes that "central processing location" is not a term with a specialized meaning in the relevant art, and Acacia presents no dictionary that defines this term as a whole. Acacia relies instead on the "ordinary" dictionary definition of the word "central" to give effect to the claim limitation. *See* Acacia's July 21, 2006, *Markman* Brief ("Acacia Brief") at 8 n.4; Declaration of Alan A. Block In Support of Acacia's July 21, 2006, Markman Brief ("Block

Decl.”), Ex. 9. In the context of the claim term “central processing location,” however, the word “central” is not sufficiently precise for those of ordinary skill in the art to know how to practice the claimed invention — or avoid doing so. In addition, the specification also lacks any reference point to define the parameters of the limitation “central processing location.”

The term “central” refers to the “center” of some *thing* or *place*. Acacia’s own dictionary illustrates this concept:

> 1: containing or constituting a center: relevant or pertinent to a center
>
> 2: belonging to the center as most important part
>
> 3 a: situated at, in, or near the center . . . b: placed at a center and accessible from all outlying points without undue or disproportionate difficulty.

See Block Decl., Ex. 9 at 363 (quoting *Webster’s Third New Int’l Dictionary, Unabridged*). These definitions make clear that, in the context of “central processing location,” the term “central” is an adjective that references a “center.” And yet, neither the claim language nor the specification provide any guidance regarding what the “central processing location” is the “center” of. For example, the “central processing location” could be the geographic center of a transmission system, *i.e.*, located at the physical center of a regional system, or it could be the functional center of a transmission system, *i.e.*, the single location where functions in the transmission system are performed. But, the specification never describes *any center*, whether functional or geographic There is nothing in the patent that defines “central” or “central processing location” sufficient to provide any reasonable notice to the public regarding what exactly the patentees are claiming as their invention.

This ambiguity causes substantial uncertainty in applying the claim language to actual systems. For example, is a satellite uplink facility that is located in California and that transmits signals to a fleet of satellites in space for downlinking across the United States a central processing location? It is not geographically central to either the satellite fleet or to the service area to which the satellites are directed.

What if the satellite system employs several uplink facilities? Is each of these facilities a central processing location, even if none is geographically central and all signals are ultimately transmitted to subscribers across the United States? Must the central processing facility be central with respect to the local distribution systems to which, according to the claims, they must transmit? If the local distribution systems are themselves central to their distribution areas, are they also central processing locations?

How much processing must take place at a location to qualify as a central processing location? Claim 14 of the '863 patent only explicitly requires that the central processing location transmit signals to the local distribution system, while Claim 17 seems to require that compression, digitization, and transmission occur at the central processing location.

Such questions are important to competitors trying to determine the scope of the claimed systems. Yet, there are no clear answers based upon the plain language of the term or the claims in which they are used.

B. Acacia's Proposed Construction Should Be Rejected.

Acacia asserts that "central processing location" means "the principle [*sic*] position or site where processing occurs." Acacia thus tries to import the concept of "principal" into the construction of "central processing location." However, Acacia's construction does nothing to solve the inherent ambiguity in the term.

1. There Is No Way to Determine Which Processing Location Is the "Principal" One.

Acacia's construction implies that multiple "processing locations" exist, but that one of them is the "principal" processing location. The specification does not provide any way to determine *which* of the multiple locations would be the "principal" processing location. If, for example, a transmission system has five locations at which processing functions are performed, there is no way to determine which, if any, of these locations would be the "principal" location.

The specification highlights the ambiguity created by Acacia's proposed construction. Figure 1c identifies multiple transmission systems, each of which transmits to multiple reception systems. Neither Acacia's proposed construction nor the specification provides *which* of these transmission systems is at the "central processing location." Similarly, the specification provides that the transmission system "may either be located in one facility or may be spread over a plurality of facilities." '863 patent, 5:56-60. If an accused infringer houses its transmission facilities at a number of different locations, it is impossible to know which facility, which location, or which combination of facilities or locations is the "principal" facility. Acacia's proposal that the Court simply replace the word "central" with the word "principal" does nothing to solve the inherent ambiguity in the term "central processing location" and still leaves broadcasters able only to guess at the alleged invention's scope.

Even if Acacia's proposed "principal" definition had some content, it would still, at best, suggest one possible construction of the term "central," along with "geographically" or "functionally" central. But where two or more plausible definitions apply to a claim term and the specification, the claims, and the applicable field of art do not resolve which definition applies, the term is indefinite. *See Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed. Cir. 2001). In *Union Pacific* the patent disclosed a method for determining the location of a borehole in the earth. A method claim called for "comparing" "characterizing information" from a borehole to "characterizing information" from an offset location. *Id*. at 688. However, the specification did not indicate "[t]he precise meaning of the term 'comparing.'" *Id*. at 692. The claim language could have been referring to a "complex correlation step" — as plaintiff argued — or to the plain and ordinary meaning of the term "comparing" — as defendant argued. *Id*. Because the patent did not "define the means to 'compare' the two sets of characterizing information," the court affirmed the district court's finding of indefiniteness. *Id*. Acacia's construction of "central" does nothing more than create a situation akin to *Union Pacific*. Rather than addressing the definitions that state that "central" means the "center" of some *place* or *thing*, Acacia imports the amorphous term "principal" into its proposed construction. Acacia's proposed construction creates more ambiguity than it resolves.

2. Federal Circuit Authority Does Not Support Acacia's Proposed Construction.

Acacia mistakenly relies on *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322 (Fed. Cir. 2006), and *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367 (Fed. Cir. 2004), in support of its "central processing location" construction. In *Wilson Sporting Goods*, the court construed the term "annular." 442 F.3d at 1328. Because the term was not used in the specification and because there was no evidence that the term had a peculiar meaning in the field of art, the court applied the ordinary meaning. *Id*. However, unlike here, the term "annular" had a single, established meaning that defined the bounds of the invention. *See id*. at 1328. Here, application of the several asserted "ordinary" meanings of "central" does the opposite — it creates hopeless ambiguity that the specification does not resolve.

Bancorp Services is similarly inapplicable. In that case, the Federal Circuit determined that the term "surrender value protected investment credits," a term used only in the claim language, would be understood by one skilled in the art to mean the same thing as "stable value protected investment credits," which was used in the specification. 359 F.3d at 1372. In addition, the court found that the specification's use of the acronym "SVP" was so close to "surrender value protected investment credits" that the inference was inescapable that "SVP" was intended to be equivalent to the disputed term. *Id.* at 1373.

The *Bancorp Services* holding is consistent with *Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353 (Fed. Cir. 2005), another case on which Acacia relies. There, as this Court noted in its December 2005 *Markman* order, the Federal Circuit relied on references to the term "download file" in the specification to define the term "download component," a term that was only used in the claim language. *Id*. at 1360-61; *see also* Declaration of David M. Hymas in Support of Satellite Defendants' Memorandum Re the Definitions of Terms in the '863 and '720 Patents ("Hymas Decl."), Ex. A at 9 (December 2005 *Markman* Order ("*Markman* II")).[2] Of course, in contrast to both *Bancorp Services* and *Network Commerce*, neither the specification nor the claim language of the '863 and '720 patents use the terms "central" or "central processing location" interchangeably with any other term or refer to either term with an acronym. The intrinsic record simply provides no guidance regarding the meaning of the terms "central" or "central processing location."

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[2] As this Court also noted, *Network Commerce* was not an indefiniteness case. *Markman* II at 9. The Federal Circuit was construing the disputed term to determine whether it should certain limitations such as a "boot program." *Network Commerce*, 422 F.3d at 1360-61.

3. Acacia's Construction Fails to Give Content to the Concept of a "Central" Processing Location.

Acacia's proposal also fails because it does not give adequate content to the concept of a "central" processing location that transmits to local distribution systems. If the Court were to construe the term, it should include in any such construction the concept that the "central" processing location is "a *single* location at which all of the audio and video information to be received by the local distribution system is formatted as compressed, digitized data and transmitted."

Figures 1a-1g help to illustrate this concept. In each of these figures, the depicted reception systems receive transmissions from *one and only one* transmission system. Figure 1c, for example, shows several transmission systems. But each of the transmission systems has its own set of reception systems to which it transmits information. The patent consistently describes these "spoke-and-wheel" configurations. Indeed, the patent nowhere describes an instance where a reception system receives transmissions from two different transmission systems. To the extent the patent provides any support for a "central" processing system where transmission occurs, it includes the requirement that the "central" processing location is a single location (whether geographically central or not) at which all of the audio and video information to be received by the claimed local distribution system is processed and from which that information is transmitted.

II. THE UNIQUE IDENTIFICATION CODE IDENTIFIES THE ITEM HAVING INFORMATION[3]

The phrase "assigning a unique identification code to the item having information" from Claim 17 of the '863 patent should be construed to mean that the "one-of-a-kind identifier is assigned to the item having information." Claim 17 of the '863 patent includes a "formatting step" whereby items of audio/video information are formatted as compressed, digitized data. Claim 17 goes on to further describe these formatting steps and, as part of this description, provides for "assigning a unique identification code to the item having information." This assigning step is followed by steps that provide for formatting and compressing of the information. Since this Court has already construed "unique identification code" to mean a "one-of-a-kind identifier," the assigning step of Claim 17 should be construed — consistent with the plain meaning of its terms — to mean that the one-of-a-kind identifier identifies the item having information through the formatting and compressing processes. *See* Hymas Decl., Ex. B at 14 (July 2004 *Markman* Order ("*Markman* I")).

Acacia agrees that the identifier is assigned to the item having information. *See* Acacia Brief at 19. However, despite the unambiguous claim language, Acacia's proposed construction provides that the identifier "identifies *the information* through the formatting and compressing processes." *Id.* at 19-21 (emphasis added). That is not what the claim provides. The claim language clearly states that the unique identification code is assigned to "*the item having information*." Thus, the one-of-a-kind identifier identifies "the *item* having information" — not just "the information" as Acacia contends — through the formatting and compressing processes.

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[3] The parties' positions on construction of this term are found in Item No. 3 in the Joint Claim Chart.

III. THE FORMATTING STEP OF CLAIM 17 REQUIRES ONLY THAT INFORMATION BE SEQUENCED AS ADDRESSABLE DATA BLOCKS[4]

The phrase "formatting the item having information as a sequence of addressable data blocks" should be construed to mean "converting the format of the item into a sequence of addressable data blocks." Acacia's proposal, which specifies "placing the formatted information into time encoded data blocks," incorrectly specifies that the sequence of addressable data blocks must be time encoded. *See* Satellite Defendants' May 8, 2006, Memorandum Re the Definitions of Terms In Claims 41-45 of the '992 Patent [Doc. No. 157] at 26-31.

IV. THE "LOCAL DISTRIBUTION SYSTEM" MUST BE LIMITED TO A PARTICULAR GEOGRAPHIC REGION[5]

Claim 17 of the '863 patent and Claims 8 and 11 of the '720 patent all specify transmission of audio/video information in two steps. First, a "central processing location" sends data to a "local distribution system." Second, the local distribution system sends data to "subscriber receiving stations" (or "subscriber selectable receiving stations").[6] The construction of the phrase "local distribution system" is complicated by the fact that the specification never uses the phrase. Nonetheless, based on the ordinary meaning of the words, what may be gleaned from the context of the patent as a whole, and, in particular, the prosecution history, the term "local distribution system" should be given the following construction:

> An assembly of elements, hardware, and software, at a local geographic region (such as a town or city), functioning together to receive, store, decompress, and transmit audio and video information to subscriber receiving stations confined to that same local geographic region.

Acacia disagrees, and offers the following construction:

> [A]n assembly of elements, hardware and software, that function together to receive transmitted data, store the data, decompress the

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[4] The parties' positions on construction of this term are found in Item No. 4 in the Joint Claim Chart.

[5] The parties' positions on construction of this term are found in Item No. 5 of the Joint Claim Chart.

[6] Claims 4, 8, and 11 of the '720 patent introduce the term "selectable" as part of the claim limitation "subscriber receiving stations."

> data, and transmit the data to at least one subscriber receiving station.

Acacia's proposed construction is plainly wrong because it completely ignores the word "local." Indeed, under Acacia's proposed construction, a satellite that broadcasts to an entire continent would qualify as a "local distribution system." Acacia's proposed construction cannot be squared with the ordinary meaning, the specification, or the prosecution history, and should be rejected.

A. The Ordinary Meaning of the Term "Local" Limits the "Local Distribution System" to a Town or City.

When the ordinary meaning of a disputed term is apparent, "claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *Phillips* v. *AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*). Here, the patentees did not act as their own lexicographers to define the term "local distribution system," and there is no peculiar meaning of the term in the field of art. Thus, the Court must look to the ordinary meaning of the term. *See Wilson Sporting Goods*, 442 F.3d at 1328 (relying on ordinary meaning of "annular" when specification failed to define term and when there was no evidence of a peculiar meaning of term in the field of art).

The first definition of "local" in *The American Heritage Dictionary of the English Language* is: "[o]f, relating to, or characteristic of a particular place." Hymas Decl, Ex. C at 1026. An alternate primary definition conveys the same concept: "[o]f or relating to a city, town, or district rather than a larger area." *Id*. Other dictionaries provide similar definitions. *See* Hymas Decl., Ex. D at 683 (*Merriam-Webster Collegiate Dictionary*) ("of, relating to, or characteristic of a particular place: not general or widespread"); Hymas Decl., Ex. E (*Oxford English Dictionary Online*) ("Belonging to a particular place on the earth's surface; pertaining to or existing in a particular region or district. … Belonging to a town or some comparatively small district, as distinct from the state or country as a whole.").

The Federal Circuit has instructed courts that they "cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history." *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) (citations omitted). Applying that principle here, the alleged purpose of the invention, as indicated by the specification itself, is to improve transmission systems, reception systems, and distribution methods for sending information to remote locations. Given this context, the correct meaning of "local" in these claims must be limited to a particular geographic region, such as a city or town. *See Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003) ("A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.") (citations omitted).

B. The Specification is Consistent with the Limitation that a "Local" Distribution System is Confined to a Geographically Limited Region.

Although the specification does not mention the term "local distribution system," it does offer as an example a "preferred embodiment" that appears to have many features in common with the system claimed in Claim 17 of the '863 patent and Claims 8 and 11 of the '720 patent. Figure 1f depicts a transmission system that sends "requested material" to a reception system, which in turn, after decompressing the material, distributes the decompressed material to end users. Thus, like Claim 17 of the '863 patent and Claims 8 and 11 of the '720 patent, this example involves a two-step transmission, from the transmission system to an intermediary system, and then from the intermediary system to the end users.

The specification describes Fig. 1f as follows:

> In the configuration of FIG. 1f, decompression of the requested material may preferably occur at the head end of a cable television reception system 200'. Thus, distribution may be provided to users via standard television encoding methods downstream of the head end of the cable distribution system.

'863 patent, 4:43-50. This description makes clear that it is the cable head end that receives, decompresses, and transmits audio/video information to end users. These functions are the *same* functions for which the local distribution systems of the '863 and '720 patent claims are responsible. For example, Claim 14 of the '863 patent specifies that it is the local distribution system that receives compressed, digitized data from the central processing location, stores that data, decompresses the data, and then retransmits the decompressed data to a subscriber receiving station. Claims 8, 9, and 10 of the ‘720 patent specify a similar process.

Notably, both in 1991 and now, a “cable head end” is the origination point of a cable television system and generally includes satellite antennas, converters, modulators, and related equipment. *See* Hymas Decl., Ex. F at 446 (*Newton’s Telecom Dictionary*); Hymas Decl., Ex. G (*Telecommunications Regulation: Cable, Broadcasting, Satellite, and the Internet*). And, like the local distribution systems of the ‘863 and ‘720 patent claims, cable head ends act as the origination point for cable television systems in *discrete geographic areas* the size of a city or town. *See* Hymas Decl., Ex. H (Regional Cable Headend) (“The regional cable headend serves as the local data network operations center”); Hymas Decl., Ex. I (Cable Data Network Architecture) (cable headend typically serves 200,000-400,000 homes).[7] Of course, because the local head ends are in discrete geographic regions, such as cities or towns, the subscribers the head ends serve are also in those same geographic regions. Again, this geographic relationship is similar to the relationship between the local distribution system and the subscriber receiving stations, which in Claims 14 and 17 of the ‘863 patent are “coupled to” the local distribution system. At the June 14, 2006 *Markman* hearing, counsel for Acacia confirmed that a cable head end acts as such a local distribution system:

> The Court: What is the head end of a cable?
>
> Mr. Block: It’s the place in the cable system from which *local distribution* is made, so there may be a main, a main transmission of the program HBO sends a movie to many different cable head ends. So San Jose, for instance, may have its own cable head end located *within so many miles of your home*.
>
> And so that information is sent from one place to the head end and from the *head end it can then be distributed to the homes in that, in*

---

[7] *See also* Hymas Decl., Ex. J (Webopedia) (“A cable television company’s *local facility* that originates and communicates cable modem and cable TV services to its subscribers”) (emphasis added); Hymas Decl., Ex. K (Searchnetworking.com) (“A cable head-end (or headend) is the facility at a *local cable TV office* that originates and communicates cable TV services and cable modem services to subscribers”) (emphasis added).

> *that area* that are attached to or connected or coupled with that head end.

Hymas Decl., Ex. L at 209:6-19 (emphasis added).

Further support for the Satellite Defendants' construction is also found in the specification's use of the word "local" in analogizing an aspect of the invention to a "local public library":

> [T]he first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user of the distribution system (step 412). This is analogous to taking books off of a shelf at the *local public library* after the person has decided that he or she would like to read them.

'863 patent, 18:1-7 (emphasis added). A "local public library" serves users in the same city or town, in much the same way as the "local distribution system" serves subscribers confined to the same local region.

C. The Prosecution History of the '720 Patent Strongly Supports the Construction that a "Local Distribution System" Is Limited to a Geographic Region Such as a City or Town.

The prosecution history supports the Satellite Defendants' proposed construction. The application that gave rise to the '720 patent was filed in April 1996, along with an amendment that canceled Claims 1-32 and added new Claims 33-42. *See* Hymas Decl, Ex. M (4/10/96 Preliminary Amendment). Several of those claims, including Claim 39, included a "local distribution system" as an element. *Id.* at 5. In a July 24, 1997, Office Action, the PTO rejected all of the pending '720 claims. Hymas Decl., Ex. N at 2-4. In particular, the PTO found that Claim 39 and its dependent claims were anticipated by a patent issued to Tindell, *et al*. *Id.*

In a Response dated November 21, 1997, the applicants made no amendments to the claims, but attempted to distinguish Tindell by arguing that Tindell did not disclose a "local distribution system." According to the applicants:

> Use of a local reception or distribution system is neither taught nor suggested by *Tindell et al.* and such a system considerably simplifies and reduces the cost of the components required at the user end. That is, *by storing the requested compressed information locally*, the subscriber does not need to have compressed data storage or decompression circuitry at his location. Rather, a local facility can have these elements and they can be *distributed or shared between a plurality of users in a local region*.

Hymas Decl., Ex. O at 3-4 (emphasis added). This clear statement by the applicants confirms two aspects of the local distribution system:

- First, the "local distribution system" distributes information to "a plurality of users *in a local region*" — as is made clear in the Satellite Defendants' proposed construction.
- Second, the "local distribution system" stores information "locally" at "a local facility" — and thus must be located in the same geographic region where the subscriber receiving stations are located. The applicants touted the advantages of this approach as reducing costs and increasing efficiency.

In short, the prosecution history confirms that the term "local distribution system" should be construed as proposed by the Satellite Defendants.

D. Acacia's Proposed Construction Impermissibly Ignores the Word "Local."

Acacia agrees that persons of ordinary skill in the art in 1991 would have understood the meaning of "local distribution system" according to the "ordinary meaning of its constituent terms." Acacia Brief at 25. Acacia nevertheless entirely ignores the meaning of the word "local." Acacia's proposed construction makes no effort to construe the term "local," either in the abstract or within the context of the claim language and the disclosed invention.

Acacia contends that because Claims 14 and 17 "are silent as to any particular communication channel," they must then "include satellite broadcasting." *See id.* at 26-27. Acacia's argument misses the point. The Satellite Defendants' proposed claim construction — which gives meaning to the term "local" distribution system — does not categorically exclude satellite transmission or any other type of "communication channel." It merely requires that the local distribution system be situated in a local geographic region (such as a town or city), and transmit audio/video information to subscribers located only in that same region. If a television broadcasting system were configured in such a way, it would not escape infringement by virtue of using a satellite "communication channel."

Acacia's attempt to write out the "local" part of the phrase "local distribution system" should be rejected, as it is contrary to the ordinary meaning of the words, the specification, and the prosecution history.

V. "STORING . . . THE COMPLETE COPY OF THE AT LEAST ONE ITEM" SHOULD BE CONSTRUED CONSISTENT WITH THE PARTIES' PRIOR STIPULATION[8]

The phrase "storing . . . the complete copy of the at least one item" in Claims 14 and 17 of the '863 and Claims 8 and 11 of the '720 patents is similar to the phrase "storing a complete copy" as used in Claim 19 of the '992 patent and Claims 2 and 5 of the '275 patent. As part of the June 2006 round of *Markman* briefing regarding the '992 and '275 patents, the parties stipulated that "storing a complete copy" meant "storing a copy such that all of the received information is in storage at the same time." Consistent with the parties' June 2006 stipulated constructions, the Satellite Defendants agree with Acacia that the phrase "storing . . . the complete copy of the at least one item" means "storing a copy such that all of the received data is in storage at the same time."

VI. "IN RESPONSE TO THE STORED COMPRESSED, DIGITIZED DATA, TRANSMITTING" MEANS THAT INFORMATION IN THE STORED DATA TRIGGERS TRANSMISSION[9]

Claim 8 of the '720 patent recites, as one step of the claimed method: "in response to the stored, compressed, digitized data, transmitting" information to subscriber receiving stations. This phrase should be construed, according to its plain meaning, as "information in the stored, compressed, digitized data triggers the transmission."

As Acacia notes, the ordinary meaning of "response" is "an act or action of responding (as by an answer)" or "reaction." *See* Acacia Brief at 32. When the claim specifies that transmission occurs "in response to the stored, compressed, digitized data," that limitation must therefore mean that transmission is in "reaction" to the data. Thus, the Court should construe the term to require

[8] The parties' positions on construction of this term are found in Item No. 6 in the Joint Claim Chart.

[9] The parties' positions on construction of this term are found in Item No. 7 in the Joint Claim Chart.

that information in the data *triggers* transmission. Acacia complains that the word "triggers" is not used by the dictionary, which instead uses the word "reaction." *Id*. Acacia's quibble does not address the substance of the construction. The Court could instead adopt the construction "transmission occurs in reaction to information in the stored, compressed, digitized data," which would also convey the needed concept.

Acacia also contends that the phrase means only that transmission occurs "*after* the compressed, digitized data has been stored." *Id*. Acacia's construction cannot be squared with the claim language. The claim states that transmission is in response to the *data*, not in response to the *completion of storage of the data*. Acacia's lengthy discussion of embodiments that employ partial or complete buffering is also irrelevant. *See id.* at 31. None of the language from the specification about buffering discusses transmission "in response to" data. If the patentees had intended to specify buffering in this claim, they could have used the word "buffering." They did not. Instead, they specified that transmission must occur "in response to" the data. Acacia's construction should be rejected.

VII. THE TERMS "DATA REPRESENTING" AND "REPRESENTATION" ARE INDEFINITE[10]

Each of the asserted claims of the '863 and '720 patents requires transmitting "data representing" an item from a first location to a second location, and transmitting "a representation" of the item from the second location to a third location. For example, Claim 17 of the '863 patent includes the limitations:

> transmitting compressed, digitized *data representing* a complete copy of at least one item of audio/video information from the central processing location; [and]
>
> using the stored compressed, digitized data to transmit *a representation* of the at least one item to at a plurality of subscriber receiving stations coupled to the local distribution system;

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[10] The parties' positions on construction of these terms are found in Item Nos. 5, 7, and 13 in the Joint Claim Chart.

'863 patent, 22:25-27, 35-38 (emphasis added). The terms "data representing" and "representation" are indefinite because the scope of *what* is transmitted from one location to another is not clear. Neither the ordinary meaning of the term, the claim language, the specification nor the file history provide any assistance to a person of ordinary skill trying to determine whether or not something is "data representing" an item or a "representation" of an "item." Because one skilled in the art cannot discern the reasonable scope of these terms, they should be found indefinite.

A. The Meaning of "Data Representing" and "Representation" Is Functional and Offers No Reasonable Bounds on Their Scope.

The IEEE Standard Dictionary of Electrical and Electronics Terms 1996 defines the term "representation" as "[a] likeness, picture, drawing, block diagram, description, or symbol that logically portrays a physical, operational, or conceptual image or situation."[11] Hymas Decl., Ex. P at 911. Webster's Third New International Dictionary 1986 is consistent, defining the term "represent" as "to serve as a sign or symbol of . . . : to present by means of something standing in the place of: serve as the counterpart or image of . . . : substitute in some capacity for: act the part of, [or] in the place of . . ." Hymas Decl., Ex. Q at 1926. The same reference defines "representation" as "one that represents or is represented: as . . . a likeness, picture, model, or other reproduction." *Id.*

Thus, based on its dictionary definition, a "representation" can be anything from a symbol to a complete reproduction. For example, a representation of a book may be a picture of the book, a copy of the text, or an abstract. Indeed, a representation of the book may have no part of the book included therein or have substantially *all* of its content included. A Dewey Decimal System code, or a filename of an electronic version of the book may also be a "representation" of the book. Anything that serves to logically portray or represent something may be its representation.

[11] The 4th (1988) and 5th (1993) editions of the IEEE dictionary do not include an entry for the term "representation."

Therefore, the dictionary definitions of the terms "data representing" or "representation" offer no guidance as to what minimum quality or quantity of the represented material must be included. The scope of these terms is bounded only by the function they serve — to represent — which is completely subjective.

B. The Claim Language Compounds the Ambiguity.

Claim 17 is similar in pertinent parts to all the independent claims at issue. The claim involves three types of data sets: (1) items as compressed digitized data, (2) compressed, digitized data representing a complete copy of at least one item, and (3) a representation of the at least one item. The relevant steps of claim 17 provide:

> Formatting (1) items of audio/video information as compressed digitized data at a central processing location;
>
> transmitting (2) compressed, digitized data representing a complete copy of at least one item of audio/video information from the central processing location;
>
> receiving the transmitted compressed, digitized data representing a complete copy of the at least one item of audio/video information, at a local distribution system;
>
> storing the received compressed, digitized data representing the complete copy of the at least one item at a local distribution system; and
>
> using the stored compressed, digitized data to transmit (3) a representation of the at least one item to at a plurality of subscriber receiving stations coupled to the local distribution system.

As indicated by the language of the claim, data set (1) is located at the central processing location. In the succeeding transmitting step, however, the data that is sent to the local distribution system is data set (2). Finally, the data that is transmitted from the local distribution system to the subscribers is data set (3). Thus, the claim can be understood to involve transmitting data from the central processing location, to the local distribution system, and then to a subscriber receiving station.

But it is not clear *what* is being transmitted from one location to another. Data set (2), which is transmitted to the local distribution system, is data "representing a complete copy of [an] item." It is unclear whether this representation is itself a complete copy, a symbol of a complete copy, or an encoded or decoded version of a complete copy. Nothing in the claim or the plain meaning of the relevant terms answers this question. In addition, the confusion is only compounded by data set (3), which is transmitted to subscriber locations and may be any data that *serves to represent* the "item." Note that the claim now switches back from a representation of a "complete copy" to representation of "an item." Because data set (2) refers explicitly to a complete copy, and data set (3) does not, data set (3) presumably is something different than a complete copy and different than the representation of data set (2) — but how much different is the question. And, what is different about a representation of the "item" as opposed to a representation of "a complete copy of the item"? The claim language merely multiplies the use of unbounded terms and provides no clarity of scope.

C. The Written Description Provides No Meaningful Guidance.

The specification does not disclose an embodiment where "data representing" a complete copy of an item is transmitted from the central processing location to a local distribution system, or where a "representation" of the item is transmitted from the local distribution system to a user's location. Indeed, the phrases "central processing location," "local distribution system," and "data representing" never appear in the specification.

The word "representation" appears once in the specification but does not involve transmitting the data to a user's location. Instead, this single reference to "representation" is directed to a "block representation" of an item for storing in the source material library. '863 patent, 18:66-19:1. But there, "representation" seems to refer to the type of diagram, *i.e.*, a block diagram, shown in Figure 8d. The word "represent" appears two times in the specification. In the first instance, the specification states that digital data bytes can "represent" frames of video and audio data. *Id.*, 7:65-8:2. In the second instance, the specification provides that frames or groups of frames can "represent" still frames, chapters, songs, book pages, etc. *See id.*, 8:33-38. However, the claim explicitly requires that the data be digitized. So, representation must mean something other than digitization. Further, the suggestion that frames or groups of frames can represent a disparate list of things such as still frames, chapters, songs, and book pages is only confusing. At best, these descriptions provide examples of the *form* of what may be represented and do not provide any meaningful guidance about *what* is contained in "data representing" an item or in a "representation" of the item.

D. Acacia Offers No Support For Its Artificially Narrowed Definitions.

Acacia attempts to sidestep the indefiniteness of the terms "data representing" and "representation" by narrowing their scope and arguing that they should simply mean "reproduction." *See* Acacia Brief at 30. But this ignores settled principles of claim construction and improperly rewrites the claim in an effort to preserve its validity.

As discussed above, the dictionary meanings of "represent," "representing," or "representation" are not limited to a "reproduction." There is no support in the intrinsic record, and Acacia does not cite any, that limits the term "representation" to mean "reproduction." Moreover, to the extent "reproduction" means "complete copy," that concept is expressly recited in the claim. Thus, "representation" must be something other than a "reproduction." Indeed, using Acacia's construction in the claim requires a "reproduction [copy] of a complete copy." This construction is redundant and only undermines Acacia's position.

Also, because "data representing," "representation" and "complete copy" are different terms, the inference is that they should be construed differently. *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004). Yet, Acacia treats these differing terms as having identical constructions — again, with no explanation.

Acacia presents a further construction for "representation" with respect to Claim 14. Acacia argues: "Claim 14 itself informs persons of ordinary skill in the art that the representation of the at least one item for transmission to the at least one subscriber station is formed in the step of decompressing the compressed, digitized data representing the at least one item of audio/video information." *See* Acacia Brief at 30. Acacia bases its argument on the language of Claim 14:

> decompressing the compressed, digitized data representing the at least one item of audio/video information after the transmission step wherein *the decompressing step is performed in the local distribution system to produce the representation* of the at least one item for transmission to the at least one subscriber station.

'863 patent, 21:49-55 (emphasis added). But here again, the claim language raises more questions than it answers. Claim 14 requires two representations of the items: a compressed digitized version and an uncompressed version. While the claim may define the *form* of the representation, it does not define the *content* of the representation. Is a representation a complete digitization of the entire work, or just an abridgement, symbol or rendition? This question is not answerable. The content of a representation is undefined in Claim 14 and all other claims. Acacia cannot clarify the indefiniteness of these terms by rewriting the claim.

VIII. THE TERM "SUBSCRIBER RECEIVING STATIONS" IS INDEFINITE[12]

The term "subscriber receiving station" does not have a common and ordinary meaning. Also, it is not a term known to persons of skill in the art and is not defined in the specification or in the prosecution history. Therefore, and as discussed below, the term is not amenable to construction and must be declared indefinite.

A. Neither the Claim Language nor the Specification Clarify the Structure Or Functions of the "Subscriber Receiving Stations."

The specification describes a number of functions that are performed at the end user's location. However, neither the claim language nor the specification makes clear which of those functions are performed by a "subscriber receiving station."

Claims 4, 8, and 11 of the '720 patent and Claims 14 and 17 of the '863 patent use the term "subscriber receiving stations."[13] Claim 4 of the '720 patent is representative:

> A digital audio/video communication network comprising:
>
> a reception system in data communication with *a plurality of subscriber selectable receiving stations*, the reception system comprising,
>
> means for receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate,
>
> means for storing a complete copy of the received compressed, digitized data, and
>
> means, responsive to the stored compressed, digitized data, for transmitting a representation of the at least one item of audio/video

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[12] The parties' positions on construction of this term are found in Item No. 8 in the Joint Claim Chart.

[13] Claims 4, 8, and 11 add the term "selectable" to "subscriber receiving stations." The construction of "selectable" is addressed separately below.

> information at a real-time rate *to at least one of the plurality of subscriber selectable receiving stations*, wherein said means for receiving, said means for storing, and said means for transmitting are positioned at the same location, and wherein the at least one of the plurality of subscriber selectable stations is located at a premises geographically separated from the location of the reception system.

'720 patent, 19:42-62 (emphasis added). The claim specifies certain functions for the "reception system," but all the claim says about the "subscriber receiving stations" is that (1) they are in "data communication" with the reception system, (2) the reception system transmits information to them, and (3) they are "geographically separated" from the reception system.[14] Nothing in the claim language indicates what the subscriber receiving station is *in terms of structure or scope*.

The specification does not clarify matters. First, the specification fails to use the term "subscriber receiving station." Second, there is no way to ascribe structure to this term based on other examples that refer to steps an end user might perform or to equipment that an end user might employ. For example:

- The specification refers at one point to "users who only have cable television decoders and standard television receivers." '863 patent, 4:47-49. Assuming this user is also a "subscriber," is the "subscriber receiving station" a "cable television decoder"? Is it a "standard television receiver"? Is it a location or place where such equipment might be located? The specification does not make any of this clear.
- The specification also describes information that is output to "a playback system such as a TV or audio amplifier" or to "an audio/video recorder for more permanent storage." *Id.*, 17:53-55, 16:47-49. Again, nothing in the specification indicates whether any of these items is a "subscriber receiving station."

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[14] The other claims are similar. Claims 14 and 17 of the '863 refer to the "local distribution system" rather than the "reception system," and provide that the subscriber receiving stations are "coupled to" the local distribution system.

- The specification discusses user systems that recognize copy-protected programs and disable any audio/video recorder the user might have to copy a program. *Id.*, 5:45-48. Whether these functions are performed by a "subscriber receiving station," the specification provides no answer.

Acacia's brief only serves to highlight the indefiniteness problem. In addressing whether the term "subscriber receiving station" refers to "a set-top box" or to "a separate television," Acacia notes that "[t]he specification actually describes two possible devices, the reception system 200 and the playback device." Acacia Brief at 34 n.12. That, however, is precisely the problem: the specification provides many different *possible* meanings without providing any guidance as to the one (or ones) that should apply.

Where multiple possible definitions could apply to a claim term and neither the specification, the claims, nor the applicable field of art resolve which definition applies, the term must be found indefinite. *Union Pac.*, 236 F.3d at 688. Here, as in *Union Pacific*, the specification describes many possible structures that could reside at the "subscriber's" location, and many possible functions that could be performed there. One of skill in the art can only guess as to which of these are part of the "subscriber receiving station." These claims are indefinite.

B. Acacia's Proposed Construction Should Be Rejected.

Acacia argues that the term "subscriber receiving station" should be given essentially the same construction as the "reception system" previously construed by the Court: "a subscriber's assembly of elements, hardware and software, capable of functioning together to receive a representation of an item of audio/video information." Acacia Brief at 32; *see also id.* at 35 ("The term 'receiving station' is used in claims 14 and 17 in a similar manner to 'reception system' in the claims of the '702 patent" . . . [and] would be understood to have a similar meaning").

Acacia ignores the well-known cannon of claim construction: "the use of [different terms] in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each." *Bancorp Servs.*, 359 F.3d at 1373; *see also Innova/Pure Water*, 381 F.3d at 1119 ("[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms.").

Here, in Claim 4 of the '720 patent the patentees refer to two *different elements* in close proximity: "a reception system in data communication with a plurality of subscriber selectable receiving stations." Whatever a "receiving station" is, it must be something different from a "reception system." Acacia's proposed construction is in clear violation of this basic claim construction principle.

Acacia's proposed construction also relies on what Acacia argues to be the ordinary meaning of "station." According to Acacia, the word "'station' has an ordinary meaning of 'a complete assemblage of radio or television equipment including antenna, transmitting or receiving set, and signal making or reproducing device.'" Acacia Brief at 33-34. Acacia's partial quotation from an inapposite definition does not establish the ordinary meaning of the term "station" and ignores Federal Circuit instruction proscribing reliance on abstract, selective dictionary definitions. *See Phillips*, 415 F.3d at 1321. ("The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.")

Acacia's definition is from Webster's Third New International Dictionary. Block Decl., Ex. 4. Webster's is not a technical dictionary from the field of the patent. Moreover, Webster's provides a total of *10* definitions of the word "station," each with multiple sub-definitions. Acacia has chosen to quote from *part* of the ninth definition for "station," but provides no explanation of why this definition is more apposite than others given by Webster's. In addition, the full definition cited by Acacia shows that the dictionary was actually providing a definition of the word "station" as used for "a place established to provide a public service," and thus has no relevance here. The complete ninth definition of "station" in Webster's is as follows:

> 9: *a place established to provide a public service as*
>
> a: FIRE STATION
>
> b: POLICE STATION
>
> c: a post office subsidiary to the headquarters post office of an area: a branch post office — see CLASSIFIED STATION, CONTRACT STATION

d (1): a complete assemblage of radio or television equipment including antenna, transmitting or receiving set, and signal making or reproducing device

(2): the place (as a room) in which a radio or television transmitting or receiving station is located

e: a usually outdoor place where merchandise is sold: STAND

Id. (indenting and emphasis added).

In context, it is clear that the ninth definition for "station" is describing "a place established to provide a public service," one example of which is a television or radio station. Obviously, whatever a "subscriber receiving station" is, it is not "a place to provide a public service," and it is not equivalent to a television or radio station. Acacia's use of this definition provides no support for an ordinary meaning of the term "subscriber receiving station." Nor do any of the other dictionary definitions of "station" provide any ordinary meaning of the term that would be relevant to the patent at issue. Although the other definitions include the concept of "place," that only compounds the problem — is a "subscriber receiving station" a place or an assembly of equipment (as in "computer work station"). In short, Acacia has failed to show an ordinary meaning that could save this term. The term is indefinite.

IX. THE STEP OF "USING THE STORED COMPRESSED, DIGITIZED DATA" TO TRANSMIT A REPRESENTATION IS INDEFINITE[15]

Claim 17 of the '863 patent and Claim 11 of the '720 patent are method claims each including the limitation, "using the stored compressed, digitized data" to transmit a representation.[16]

Limitations of a method claim are acts or manipulative steps. Here, the term "using" does not inform a skilled artisan what *act* or *series of acts* must be performed to practice the step of "using the stored compressed, digitized data." Because the ordinary meaning of the term "using" fails to indicate any specific *act* and because the intrinsic record does not provide any guidance to what *acts* are covered by the claim, this limitation should be found indefinite.

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[15] The parties' positions on construction of this term are found in Item No. 14 in the Joint Claim Chart.

[16] As shown in Section VII herein, the term "representation," as used here and in other claims, is indefinite.

A. The Term "Using" Fails to Specify the *Acts* Covered by the Claim.

Claim 17 of the '863 patent includes the step of:

> *using the stored compressed, digitized data to transmit a representation* of the at least one item to at a plurality of subscriber receiving stations coupled to the local distribution system.

(emphasis added). And Claim 11 of the '720 patent includes the step of:

> *using the stored compressed, digitized data to transmit* using a transmitting means *a representation* of the at least one item to at least one of a plurality of subscriber selectable receiving stations coupled to the local distribution system.

(emphasis added). Thus, in each limitation, the plain language requires that the "stored compressed, digitized data" is *used* to transmit a representation — but how? The ordinary meaning of the term "using" gives no help on this point.[17] That is, a step of "using" is independent of any specific *act* or *series of acts* that must be performed.

Ex parte Erlich, 3 U.S.P.Q.2d 1011 (B.P.A.I. 1986), explains the insufficient nature of the term "using" in a method claim. There, the claim read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." *Id*. at 1012. Because the claim only recited "using monoclonal antibodies" without any "active, positive steps" delimiting how the use was practiced, the PTO Board of Appeals held the claim to be indefinite. *Id*. at 1017.

The test of indefiniteness is whether a person of ordinary skill in the art can understand the metes and bounds of the claim. Here, one can discern only that the "stored compressed, digitized data" is in *some way used* "to transmit a representation." But the *act* or *series of acts*

[17] Webster's Third New International Dictionary 1986 defines "use" as, "to put into action or service: have recourse to or enjoyment of: EMPLOY," or "to carry out a purpose or action by means of: make instrumental to an end or process: apply to advantage: turn to account: UTILIZE." Although the dictionary also provides other possible definition of "use" (e.g., "to observe or follow as a custom: behave," "to expend or consume by putting to use," "to bear in relations with others," "to apply or have applied as the usual designation," and "to benefit from the use of."), in the context of the claims and the specification here, these definitions do not appear applicable. *See* Hymas Decl., Ex. R at 2523-24.

that may infringe the claim are not clear. Just how is the digitized data used? Must there be information in the stored digitized data that triggers a transmission of the representation? Must there be information embedded in the stored digitized data defining the channel used for transmission, or defining the address of the subscriber who will receive the transmission? One cannot tell.

B. The Specification Does Not Resolve the Ambiguity.

The specification provides no help. The terms "use" and "using" are mentioned in the specification, but not in the context of Claims 17 and 11 and not in connection with "stored compressed, digitized data." The term "representation" is mentioned only one time — in an irrelevant context of storing data into the source material library — not for transmitting to a subscriber's location from a local distribution system. There is no mention of *using* stored compressed data for the purpose of facilitating transmission.

Acacia argues that Figures 1d-1g of the specification are relevant because they disclose "cable television systems in which the audio/video information is stored at a local distribution system and then transmitted to the subscriber for viewing." Acacia Brief at 45. But these figures have little resemblance to the claimed steps. The plain language of the claims requires the stored compressed, digitized data at the local distribution system to be *used* to transmit a representation. Indeed, the sections cited by Acacia do not describe "using" any stored compressed, digitized data, or transmitting any "representation." The specification does not disclose *any* acts that are performed that correlate to the step of "using" as recited in Claim 17 of the '863 patent and Claim 11 of the '720 patent.

C. Acacia Improperly Rewrites the Claim.

Acacia proposes that a "reproduction" of the "stored compressed, digitized data" is the "representation" that is transmitted to the subscriber's location. *Id*. at 44-45. Acacia thus attempts to avoid the unexplained relationship between "using," "stored compressed, digitized data," "transmit," and "representation" by introducing a new term, "*reproduction*," and deleting "*using*." In effect, Acacia rewrites the limitation as follows:

> Transmitting a reproduction of ~~using~~ the stored compressed, digitized data to ~~transmit a representation of the at least one item to at~~ a plurality of subscriber receiving stations coupled to the local distribution system.

This proposal is impermissible: the phrase "using the stored compressed, digitized data to transmit" must be given effect, and the *act* or *series of acts* defined. Also, the plain language of the claim provides that the "representation" is transmitted to the subscriber location — not the "stored compressed, digitized data" or a "reproduction" thereof. There is no support in the intrinsic record — and Acacia does not cite any — to indicate that "a representation" of an item is a reproduction of "the stored compressed digitized data." Indeed, the word "reproduction" is never mentioned in the specification.

Acacia cannot avoid indefiniteness by rewriting the claim.

X. THE STEPS OF CLAIM 17 IN THE '863 PATENT AND CLAIMS 8 AND 11 IN THE '720 PATENT MUST BE PERFORMED IN ORDER AND AFTER PRIOR STEPS ARE COMPLETED[18]

The language of Claims 17 of the '863 patent and 8 and 11 of the '720 patent, as well as the specification, requires that the steps of these method claims must be performed in the order recited and that subsequent steps are performed only after prior steps have been completed. The parties have stipulated that the claims' respective steps must be performed in the order recited by the claims. *See* 7/21/06 Parties' Stipulated Definitions for Claim Terms from the '863 and '720 Patents [Doc. No. 187] at 5-6. However, Acacia continues to disagree with the Defendants regarding the fact that prior steps have to be completed before subsequent steps begin.

This issue is the same dispute that was before the Court with regard to the steps of Claim 41 in the '992 patent, which was at issue during the June 2006 round of *Markman* briefing. *Id.* at 4. Rather than reargue the issue, the Satellite Defendants simply refer the Court to their briefing on the issue in their *Markman* brief on the '992 patent at pages 6-12.

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[18] The parties' positions on construction of this term are found in Item No. 15 in the Joint Claim Chart.

XI. "SUBSCRIBER SELECTABLE" MEANS THAT THE LOCAL DISTRIBUTION SYSTEM OR THE RECEPTION SYSTEM MUST PROVIDE THE SUBSCRIBER WITH A CHOICE: TO WHICH OF THE PLURALITY OF RECEIVING STATIONS WILL THE INFORMATION BE TRANSMITTED[19]

The '720 patent adds the term "selectable" to the phrase "subscriber receiving stations." This addition is important because it carries out the patent's stated purpose of sending information to particular remote locations selected by the subscriber. Acacia agrees, for the most part, with the Satellite Defendants' construction regarding this subscriber choice. Subscribers are provided a choice, from among many different receiving stations, which particular station or stations will receive transmitted information. However, Acacia ignores the additional implication of the term "subscriber selectable" — something must provide that choice to the subscribers. In the '720 patent, this choice of which subscriber receiving station will receive transmitted information is provided by the reception system (Claim 4) or the local distribution system (Claims 8 and 11).

Acacia's proposed construction is that the subscriber must be "presented with the option of choosing, from among the plurality of receiving stations, the receiving station to which information is transmitted." Acacia's proposal is vague, however, as to what system or component "presents" the subscriber with this choice. Given the claim language, it is clear that the "reception system" (in Claim 4) and "the local distribution system" (Claims 8 and 11) are the structures that provide the choice to the subscriber. The reception system of Claim 4 is the only structure that is "in data communication with" the various subscriber receiving stations. Similarly, the local distribution system is the only structure that is "coupled to" the subscriber receiving stations. These structures must be the ones providing the choice to the subscribers. Indeed, Acacia offers no explanation for what other structure might be responsible for this task.

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[19] The parties' positions on construction of this term are found in Item No. 16 in the Joint Claim Chart.

XII. THE "MEANS, RESPONSIVE TO THE . . . DATA, FOR TRANSMITTING A REPRESENTATION . . ." LIMITATION LACKS CORRESPONDING STRUCTURE AND IS INVALID UNDER § 112, ¶ 2[20]

Claim 4 of the '720 patent includes as a limitation "means, responsive to the stored, compressed digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations." The parties agree that this limitation is written in "means-plus-function" format and is subject to § 112, ¶ 6.

Construction of a means-plus-function limitation involves two steps. The first step is to identify the function explicitly recited in the claim. *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). Ordinary principles of claim construction govern interpretation of the language of the function. *Id.* The second step is to identify the corresponding structure, if any, that is disclosed in the specification that performs the particular function set forth in the claim. *Id.*

Under § 112, ¶ 6, the functional scope of the "means" limitation is defined by *all* the functional language pertaining to that means. Thus, the function of this limitation must be "responsive to the stored, compressed digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations." The specification, however, does not disclose a single structure that performs this function. Accordingly, the claim is invalid for failure to satisfy the definiteness requirement of § 112, ¶ 2.

A. The Function of This Means-Plus-Function Limitation Must Include the "Responsive To" Clause.

"The function of a means-plus-function claim must be construed to include the limitations contained in the claim language." *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003). Excluding limitations from the claimed function improperly broadens the scope of the claim. *Id.* In *Lockheed Martin*, the claim included a means-plus-function limitation which read, "means for rotating said wheel in accordance with a predetermined rate schedule which varies sinusoidally over the orbit at the orbital frequency of the satellite." *Id.* at 1315 (emphasis added). The district court determined the claimed function for this limitation to be "rotating said wheel," and left out the remaining portion of the functional claim language. *Id.* at 1319-20. The Federal Circuit found this determination to be erroneous and that the district court should have included *all* the functional language that pertained to the "means" in the claimed function. *Id.*

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[20] The parties' positions on construction of this term are found in Item No. 17 in the Joint Claim Chart.

The limitation at issue here reads as follows, with emphasis on the portion of the function Acacia seeks to exclude from the means:

> means, *responsive to the stored, compressed digitized data*, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations

'720 patent, 19:52-56 (emphasis added). The "responsive to" clause is purely functional, and it plainly refers to the word "means." Under *Lockheed Martin*, this clause is part of the claim language that defines the claimed function. Although the "responsive to" clause is recited after "means" and before "for," it should still be used to define the function of the means. Indeed, the word "for" is not essential for a mean-plus-function limitation. Section 112, ¶ 6, is invoked by using the word "means," and by specifying a corresponding function for the means, without elaborating a structure to perform the recited function. *See Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997). The Federal Circuit has found § 112, ¶ 6 to be invoked even where the "means" limitation did not include the word "for." *See Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999) ("Although the phrase 'means for' is not used, the phrase 'ink delivery means' is equivalent to the phrase 'means for ink delivery,' because 'ink delivery' is purely functional); *Sage Products*, 126 F.3d at 1428 (*closure means* limitation recited without the word "for" interpreted under § 112, ¶ 6). Accordingly, the "responsive to" clause should be included in the functional definition of the means.

On the issue of identifying the claimed function, Acacia's position is set out in a single sentence: "Acacia contends that the claimed function is 'transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations.'" Acacia Brief at 52. Acacia offers no legal basis for excluding the "responsive to" clause of the claim, as none exists. Acacia simply ignores the issue.

In addition to improperly broadening claim scope, the necessary consequence of Acacia's contention is that it leaves functional language without a structural limitation. The phrase "responsive to the stored compressed, digitized data" is purely functional. But if the "responsive to" clause is not covered by this mean-plus-function limitation, then it is not clear to which the claim limitation the clause corresponds. Here, the only logical interpretation is that the "responsive to" clause relates to this "means" limitation.

B. The Claimed Function Has Three Parts.

"Ordinary principles of claim construction govern interpretation of the claim language used to describe the function." *Cardiac Pacemakers*, 296 F.3d at 1113. Here, the properly identified claim function has three parts:

a. responsive to the stored compressed, digitized data;

b. creating a representation[21] of at least one item of audio/video information; and

c. transmitting the representation at a real-time rate[22] to at least one of the plurality of subscriber selectable receiving stations.[23]

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[21] As shown in Section VII herein, the term "representation," as used here and in other claims, is indefinite.

[22] The parties agreed by stipulation that "real-time rate" means a rate (described in terms of time) that is the actual rate (described in terms of time) during which a particular item (e.g., video or audio) is listened to or viewed. *See* 7/21/06 Parties' Stipulated Definitions for Claim Terms from the '863 and '720 Patents [Doc. No. 187] at 2.

[23] As shown in Section VIII, the term "subscriber selectable receiving stations," as used here and in other claims, is indefinite.

First, the plain language of the claimed function requires that the "means" must be "responsive to the stored compressed, digitized data." This phrase means that information in the stored, compressed digitized data triggers the transmission and is fully briefed above in Section VI.

Second, the claim requires that the means transmit "a representation of the at least one item of audio/video information." However, before a "representation" can be transmitted, it must exist. Because "representation" is preceded by an indefinite article "a," it does not yet exist for transmission. Thus, the means must first create or produce the "representation."

This interpretation is analogous to a previous claim construction of this Court. In *Markman I,* the Court construed a limitation in Claim 41 of the '992 patent which read,

> compressed data storing means, coupled to the data compression means, *for storing as files* the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means.

'992 patent, Claim 41 (emphasis added).

The Court found, "the functions of the 'compressed data storing means' inherent in the phrase 'for storing as files' are (1) creating a file and (2) storing the file." *See Markman* I at 23. Here, the limitation requires "transmitting a representation." Like the "file" of Claim 41, the "representation" must also be created.

Third, after "a representation" is produced, the "means" transmits the representation of at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations. According to Claim 4, the subscriber selectable receiving stations are located at a premises geographically separated from the location of the reception system, where this "means" limitation is located. *See* '720 patent, 19:11, 56-62.

C. There is No Corresponding Structure That Performs the Required Functions.

A structure is "corresponding" only if the specification *clearly links or associates* that structure to the functions recited in the claim. *Cardiac Pacemakers*, 296 F.3d at 1113. If, however, no embodiment discloses corresponding structure, the claim is invalid for failure to satisfy the definiteness requirements of § 112, ¶ 2. *Id.* at 1114. In searching the specification for a disclosed structure that performs these functions, "[i]t is important to determine whether one of skill in the art would understand the specification itself to disclose the structure, not simply whether that person would be capable of implementing that structure." *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1212 (Fed. Cir. 2003). Here, the specification fails to disclose a structure corresponding to *any* part of the claimed function.

First, there is no structure corresponding to the function, "responsive to the stored compressed, digitized data." Nothing in the specification resembles or is described as a structure where information in stored, compressed digitized data triggers transmission. The specification mentions the word "response" or "responsive" seven times. In every instance, however, "response" or "responsive" is directed to a request or an input, or is used in reference to tone and voice response hardware. *See* '720 patent, 2:50, 62, 13:30, 24, 45, 17:14, 57. These references do not describe structures that are clearly linked or associated with the function of responding to compressed, digitized data.

Second, there is no structure corresponding to the function of creating a representation of at least one item of audio/video information. As discussed in greater detail in Section VII of this brief, the term "representation" is indefinite. Indeed, the specification fails even to discuss a "representation," much less disclose a clearly linked structure that somehow creates a representation. The specification mentions the word "representation" one time. This lone mention uses the words "block representation" to illustrate items *stored* in the source material library. *See* '720 patent, 18:59-61, Fig. 8d. This is not a reference for *creating* a "representation" for transmitting. This passage also does not disclose a structure for creating the "block representation." Therefore, this disclosure cannot amount to a clear link to the function of creating a representation.

Third, there is no structure corresponding to the function of transmitting the representation at a real-time rate to at least one of the plurality of subscriber selectable receiving stations. The specification discloses structures like transmitters and transceivers that may transmit information. But even if such structures were capable of performing the function, they are not "corresponding structure" unless there is a clear link between the disclosed structures and the claimed function.

See Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc., 248 F.3d 1303, 1312 (Fed. Cir. 2001). Here, the specification does not describe or show a transmitting device for transmitting a representation. The specification also does not describe or show a transmitting device for transmitting to a subscriber selectable receiving station. Because the term "representation" is indefinite and not mentioned in a context related to this function, and because the term "subscriber selectable receiving stations" is never mentioned in the specification, the specification fails to disclose any structure clearly linked to this function.

The lack of structure linked to or associated with the claimed function, "responsive to the stored, compressed digitized data, for transmitting a representation of the at least one item of audio/video information at a real-time rate to at least one of the plurality of subscriber selectable receiving stations" renders Claim 4 of the '720 patent indefinite.

XIII. THE PHRASE "MEANS FOR INPUTTING" IS INDEFINITE BECAUSE THE SPECIFICATION DOES NOT DISCLOSE CORRESPONDING STRUCTURE[24]

The term "means for inputting" appears in Claim 7 of the '720 patent as one of the elements of the "processing station." The parties agrees that the "means for inputting" of Claim 7 in the '720 patent is governed by Section 112, ¶ 6. Thus, the Court must first determine the recited function. *Asyst Techs., Inc. v. Empak, Inc.*, 268 F.3d 1364, 1369 (Fed. Cir. 2001). Second, the court must "identify the corresponding structure set forth in the written description that performs the particular function set forth in the claim." *Id.*

A. The "Means for Inputting" Inputs Audio/Video Information Into the Processing Station.

The parties agree that the language of Claim 7 discloses that the "means for inputting" performs the function of "inputting items of audio/video information." The claim also specifies that the "means for inputting" inputs the audio/video information into the "processing station."

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[24] The parties' positions on construction of this term are found in Item No. 18 in the Joint Claim Chart.

B. The Claim is Indefinite for Lack of Corresponding Structure.

The specification fails to describe structure that performs the recited function of inputting items of audio/video information into the processing station. Indeed, it fails to describe *any* structure that inputs items, which include physical objects, into *any* system that then transmits the information contained in those items. The specification simply lacks any disclosure regarding how materials, which the specification comprehensively lists as including "television programs, movies, audio recordings, still pictures, files, books computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects," are converted into the digital and analog data inputs of the system and then input into the system. *See* '720 patent, 6:1-14; *see also Markman* I at 11 n.6 ("Neither the claims nor the specification . . . disclose any structure for converting information in the 'items' to analog or digital form as required by the 'conversion means,' before the items are stored in the library means."). Thus, the term "means for inputting" in Claim 7 of the '720 patent is indefinite.

1. Converter 113 Formats Information and is Not Responsible For Inputting the Information.

Acacia contends that portions of the "converter 113" perform the "means for inputting" function recited by the claim.[25] Acacia's argument flies in the face of the claim language, the specification, and the Court's prior order.

Claim 7 plainly differentiates between two components of a "processing station": the "means for inputting" and the "conversion means." These are both means-plus-function elements, and they are identified as performing different functions. The "means for inputting" is supposed to "input items of audio/video information." The "conversion means," by contrast, is supposed to "place each input item of audio/video information into a predetermined form as formatted data."

[25] Specifically, Acacia contends that input receiver 124 and audio input receiver 127 — both of which are part of converter 113 — are the corresponding structures of the "means for inputting" element.

The specification makes clear, moreover, that converter 113 performs the "conversion means," not the "means for inputting." The key portion of the specification is found in a paragraph immediately preceding the paragraph cited by Acacia:

> The transmission system 100 of the present invention also preferably includes *conversion means 113 for placing the items* from source material library 111 *into a predetermined format as formatted data*. . . . [A]fter identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113.

'720 patent, 6:44-51 (emphasis added). Thus, the specification teaches that converter 113 is the structure that corresponds to the "conversion means," and it is described as performing the function of "placing the items . . . into a predetermined format as formatted data." The "items" that are being converted by converter 113 plainly have already been "input" into the transmission system before they reach converter 113. The specification demonstrates that Acacia's contention that parts of the converter 113 are responsible for "inputting" items into the processing station is wrong.

Acacia's proposed construction also contradicts the Court's prior order. This Court has already found that converter 113 is the corresponding structure for the "conversion means" and is responsible for placing information into a predetermined format:

> The function of the conversion means is to "place retrieved information into a predetermined format." The specification discloses the "converter," figure 2a (113), as the corresponding structure.

Markman I at 22.

Even a cursory examination of the specification shows that it is *impossible* for converter 113, or any of its components, to input analog or digital data into the processing station. As the Court explained in its *Markman* I order, "[t]he specification defines the *inputs to the converter* as data in analog or digital form." *Id*. (citing '992 patent, 6:62-66) (emphasis added); *see also id*. at 11 ("the conversion means element 113 *only converts analog and digital inputs* into a 'formatted data' output.") (emphasis added). Thus, before converter 113, or any of its component parts, can place information into a predetermined format, that information must have *already been input* into the processing station as analog or digital data. Neither the claim language nor the specification discloses *how* or *what* inputs that information into the processing station or the transmission system. What is clear, however, is that neither converter 113 nor its components can be responsible for inputting items of digital and analog data into the processing station.

2. Acacia's Construction Cannot Be Reconciled With the Specification.

Even if Acacia could somehow show that "analog input receiver 127" and/or "digital input receiver 124" were described as structures corresponding to the means for inputting, the claim element would still be indefinite for failure to specify an adequate corresponding structure.

The specification describes the digital input receiver (124) as follows: "When the information from identification encoder 112 is digital, the digital signal is *input to the digital input receiver 124* where it is converted to a proper voltage." '720 patent, 6:57-59. This description is insufficient to teach one reasonably skilled in the art *what* the digital input receiver 124 is. The device is never described in terms of structure, its component parts, or even whether it is hardware or software. Instead, the specification leaves the public to guess regarding the device's structure.

This inadequate description is similar to the specification's inadequate description of "identification encoder," which the Court found indefinite in its *Markman* I and II orders. Acacia argued then that "identification encoder" was the corresponding structure of the "identification encoding means" of Claim 1 in the '992 patent. The Court found the specification's description of "identification encoder" inadequate because it "only define[d] the identification encoder by its function of assigning a unique identification code and does not disclose any structure, not even computer software." *Markman* I at 19. The court went on to explain that "[t]he specification does not disclose an algorithm, software or apparatus to perform the function of assigning a unique identification code." *Markman* I at 35.

The specification's "disclosure" of the digital input receiver 124 is similarly deficient. It "defines" the device in terms of its function of converting a digital signal to a proper voltage. The receiver is not otherwise described as to whether it is an algorithm, software, or apparatus. Thus, one of skill in the art would not understand the scope or bounds of the claim. For this reason alone, the "means for inputting" is indefinite for lack of corresponding structure.

If the specification's description of digital input receiver 124 is unhelpful in construing "means for inputting," it is useless with regard to analog input receiver 127. Analog input receiver 127 is one of the patents' many "black boxes" — devices identified only in figures by numbers inside of boxes or circles. With regard to the analog input receiver 127, the specification states *only*: "Converter 113 therefore includes analog input receiver 127 and digital input receiver 124. If items have only one format, only one type of input receiver 124 or 127 is necessary." *Id.*, 6:53-56. Like digital input receiver 124, analog input receiver 127 is never described in terms of its structure, its component parts, or whether it is hardware or software. The specification's oblique reference to receiver 127 is hardly sufficient structure to meet the exacting requirements of Section 112, ¶ 6. And, as this Court recognized in *Markman* I, in the absence of a link between the recited function and structure defined by the specification, the Court cannot create one. *Markman* I at 19 (citing *Medical Instrumentation*, 344 F.3d at 1212).

For all of these reasons, the Court should find that the "means for inputting" is indefinite for lack of corresponding structure and that Claim 7 is accordingly invalid for indefiniteness.

XIV. CONVERTER 113 IS THE CORRESPONDING STRUCTURE FOR THE "CONVERSION MEANS" IN CLAIM 7 OF THE '720 PATENT[26]

The phrase "conversion means," is used in Claim 7 of the '720. The parties agree that Section 112, ¶ 6 applies to "conversion means," and that the "conversion means" performs the function of "placing each item of audio and/or visual information into a predetermined format as formatted data." *See* Acacia Brief at 55. Thus, the only remaining issue is "the corresponding structure set forth in the written description that performs the particular function set forth in the claim." *Asyst Techs.*, 268 F.3d at 1369. The specification makes it plain that the recited function is performed by converter 113, as the Court has already found.

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[26] The parties' positions on construction of this term are found in Item No. 19 in the Joint Claim Chart.

A. Converter 113 is Responsible for Placing Audio/Video information Into a Predetermined Format as Formatted Data.

As explained above with regard to the "means for inputting," Claim 7 plainly distinguishes between the "means for inputting," which is responsible for "inputting items of audio/video information," and the "conversion means," which is responsible for placing "each input item of audio/video information into a predetermined format." The specification makes clear that the corresponding structure of the "conversion means" is converter 113. It states unambiguously that the transmission system includes "*conversion means 113 for placing the items* from source material library 111 *into a predetermined format as formatted data*." '720 patent, 6:44-47 (emphasis added). As explained above, this Court has already found that the structure corresponding to the identical "conversion means" in the '992 patent is converter 113. *Markman* I at 22.

B. Acacia's Proposed Structure Ignores This Court's *Markman* I Order and is Inadequate in Light of the Specification.

Acacia now proposes as corresponding structure to the "conversion means" analog audio converter 123a, analog video converter 123b, digital audio formatter 125a, and/or digital video formatter 125b. This proposed construction ignores the Court's prior *Markman* I order. Indeed, Acacia makes no attempt whatsoever to argue that the Court erred in its *Markman* I order. It simply ignores the Court's prior analysis.

Acacia's insistence on deconstructing converter 113 into its constituent parts appears to be an attempt to avoid a finding that the related "means for inputting" is indefinite. Rather than admit that the specification is deficient in this regard, Acacia has chosen to break converter 113 — which the specification unambiguously describes as responsible for placing data into a predetermined format as formatted data — down into its individual parts, all in an effort to match the various functions of Claim 7 to existing structure. Acacia's efforts are contrary to the specification's teaching and ignore this Court's prior findings.

XV. CONSTRUCTIONS OF "TRANSMITTER MEANS" AND "TRANSMITTING MEANS" [27]

A. "Transmitter Means"

1. Acacia Fails to Rebut the Presumption that "Transmitter Means" is a Means-Plus-Function Limitation.

The term "transmitter means," as used in Claim 7 of the '720 patent, should be construed pursuant to paragraph 6 of 35 U.S.C. § 112. The use of the words "means" creates a presumption that the term is governed by Section 112, ¶ 6. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 1368 (Fed. Cir. 2005). Contrary to Acacia's contention, "transmitter means" does not recite sufficient structure to rebut the presumption.

Significantly, Acacia concedes that the similar formulation "transmitting means" is governed by Section 112, ¶ 6. Acacia Brief at 60. The words "transmitter means" provide no more structure. When a term serves only to specify the function of the means-plus-function limitation, such a description does not rebut the 112, ¶ 6 presumption. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991). Moreover, as this Court found with respect to the term "library means," even if "transmitter" "is considered a structural term, the remainder of the clause invokes means-plus-function treatment, and the use of a structural term in the clause does not vitiate the patentees' intent." *Markman* I at 10.

Other courts that have considered "transmitter means" have found the term to be governed by Section 112, ¶ 6. *See Broad. Innovation LLC v. Echostar Commc'ns. Corp.*, 240 F. Supp. 2d 1127, 1148 (D. Colo. 2003) (finding that "transmitter means" was governed by § 112, ¶ 6); *see also Digital Control, Inc. v. McLaughlin Mfg. Co.*, 213 F. Supp. 2d 1242, 1247 (W.D. Wash. 2002) ("The parties do not dispute that [transmitter means] is a 'means plus function' claim.").

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[27] The parties' positions on construction of these terms are found in Item Nos. 20 and 21 in the Joint Claim Chart.

2. The Corresponding Structure of the "Transmitter Means" is the Transmitter/Transceiver 122.

The parties agree that the function performed by the "transmitter means" and recited by the claim is "sending compressed formatted data for the at least one item of audio/video information at the non-real time rate to the reception system." Thus, the Court need only determine what is "the corresponding structure set forth in the written description that performs the particular function set forth in the claim." *Asyst Techs.*, 268 F.3d at 1369.

Acacia argues that the '720 patent's specification discloses "a transmitter, transceiver, cable television transmitter, modem, broadcast television transmitter, data coupler, or satellite transmitter." Acacia Brief at 58. Acacia's construction impermissibly adds unrecited structure to the "transmitter means." The specification makes clear that transceiver/transmitter 122 is responsible for transmitting data. *See, e.g.*, '720 patent, 15:14-17, 15:54-55, 16:1-11, Fig. 2b.

While the specification does link "transmitter 122" to a modem, a data coupler, a transmitter, and a transceiver, it does not use the terms "cable television transmitter," "broadcast television transmitter," or "satellite transmitter." To qualify as corresponding structure under § 112, ¶ 6, the structure must be "clearly link[ed]" to the recited function. *B. Braun Medical Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997). Where the specification fails to even use the proposed structural term, it can hardly be said that the specification clearly links that structure to the recited function. *See Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999) ("Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure. There must be structure in the specification."). The corresponding structure of the "transmitter means" should be limited to transceiver/transmitter 122.

B. "Transmitting Means"

The parties agree that Section 112, ¶ 6 applies to the term "transmitting means" used in Claims 8 and 11 of the '720 patent. The claimed function is "transmitting data at a real-time rate to at least one of a plurality of subscriber selectable receiving stations." And, for the same reasons as with the "transmitter means," the corresponding structure is transceiver/transmitter 122.

CONCLUSION

For the reasons set forth above, the Court should construe the claims of the ‘863 and ‘720 patents as set forth above.

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